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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,794	01/31/2002	Arthur L. Rosenthal	10177-101	3444

7590 04/11/2007  
JONES DAY  
222 East 41st Street  
New York, NY 10017

EXAMINER

GHERBI, SUZETTE JAIME J

ART UNIT	PAPER NUMBER
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3738

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/11/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/062,794	<b>Applicant(s)</b> ROSENTHAL ET AL.	
	<b>Examiner</b> Suzette J. Gherbi	<b>Art Unit</b> 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 12 is/are rejected.
- 7) ☒ Claim(s) 4 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's response dated 7/25/06 has been received in application serial number 10/062,794. All comments have been considered.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown et al. 6,981,985. Brown discloses the invention as currently claimed comprising:  
A medical device for delivering a biologically active material to a body tissue of a patient in need of treatment, wherein the medical device comprises a plurality of struts (12) that form a plurality of openings (it is inherent that this is a partial view of a stent and when the entire stent is present that openings are formed); a plurality of non-structural elements (16) integral with and projecting from the struts to the openings; and a coating comprising a biologically active material disposed on the struts and the non-structural elements (see col. 5, lines 21-37 where it is inherent that even if minimally coated the

presence of coating is there nevertheless); wherein the shape of the non-structural elements are of a cone, truncated cone, an oval, a straight rod, a bent rod.

### ***Allowable Subject Matter***

4. Claim 4 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments filed 7/25/06 have been fully considered but they are not persuasive. Applicant arguments with regards to the 103 rejection (that the present application was pending on December 10, 2004 and the inventors of Brown and the present application were subject to an obligation to assign to Scimed Life Systems, Inc....") is noted and accepted.

Applicants contend that Brown et al. do not disclose or suggest "a plurality of non-structural elements integral with and projecting from the struts and that the bumpers are not non-structural elements *that are able to adjust the distribution of the biologically active material in the body tissue....*". Further applicant states that even if

Brown's bumper were non-structural elements ..that Brown does not disclose that a coating is disposed on the bumpers.

The examiner believes that applicant is not interpreting the disclosure of Brown as it applies to the way the claims are currently written.

Applicant argues that Brown's bumpers are not non-structural elements and is not convincing. The argument *"...that are able to adjust the distribution of the biologically active material in the body tissue so that the desired concentration-profile for the biologically active material released from the medical device into the body tissue.."* is not in the claim even though it is argued. Applicant's definition as noted on page 8 of the specification of a non-structural element is *"an element integral with a strut, which can project from the strut or can be located along the strut. Such non-structural elements have substantially no effect on the mechanical properties of the struts such as for example, radial strength, longitudinal flexibility,..."*. As defined by applicant the non-structural elements of Brown (i.e. 16, 16a) meet the definition of non-structural.

Further, the specification of Brown states:

*"In some embodiments of the invention a stent or portion thereof...."*. This means that the "entire stent" OR portions may be coated. Applicant's response has elected to only focus on the specification that discloses how to coat portions and has disregarded that portion that opts for the entire stent (including the bumpers/non-structural members) to be coated.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

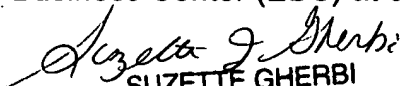
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzette J-J Gherbi whose work schedule is Maxi-Flex off every other Friday and whose telephone number is 571-272-4751.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
SUZETTE GHERBI  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 3700

03 April 2007